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IN THE

Supreme Court of the United States

October Term, 1956
No. 711

FARR COMPANY, a corporation,

Petitioner,

vs.

JULES D. GRATIOT and AIR-MAZE CORPORATION,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

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No.....

FARR COMPANY, a corporation,

Petitioner,

vs.

JULES D. GRATIOT and AIR-MAZE CORPORATION,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

Petitioner prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit, entered in the above-entitled case on October 19, 1956.

Citations to Opinions Below.

The opinion of the Court of Appeals, printed in Appendix B hereto, *infra*, pages 15-18, is reported in 111 U. S. P. Q. 170. The opinion of the District Court is unreported and is found in the record at page 819.

Jurisdiction.

1. The judgment of the Court of Appeals for the Ninth Circuit was entered on October 19, 1956 [R. 1479]. Rehearing was denied December 4, 1956 [R. 1480].

2. The jurisdiction of this Court is invoked under 28 U. S. C., Section 1254(1) to review the aforesaid judgment which reversed a judgment [R. 67, 1182] of the United States District Court for the Southern District of California, Central Division, holding Petitioner's patent valid and infringed by Respondents.

Question Presented.

The single question presented in this petition is whether this Court's decision in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U. S. 147, renders inapplicable Rule 52(a) of the Federal Rules of Civil Procedure on the question of invention in patent cases with the result that the Court of Appeals may reverse a judgment of validity on the ground that the patent does not amount to invention by simply ignoring the extensive and detailed findings of fact which fully satisfy the legal standard of invention prescribed by this Court.

Statutes and Rules Involved.

The statutory provisions involved are Sections 101 and 103 of the Patent Act of 1952; 35 U. S. C. §§ 101, 103 and Rule 52(a) of the Federal Rules of Civil Procedure. They are printed in Appendix A, *infra*, pp. 13-14.

Statement.

Petitioner, Farr Company, is the owner of United States Letters Patent No. 2,286,479 [R. 839], which issued on June 16, 1942, for an Air Filter Panel of the type commonly employed for removing dirt particles in air ventilating systems or in the intake systems to engines such as diesel railroad engines. Respondents are manufacturing and selling air filter panels which Petitioner has

charged infringe its patent, its complaint having been filed on May 27, 1949 under the patent laws of the United States.

Air filter panels of the type here involved operate on the impingement principle. That is, as the air passes through the filter the dust particles strike upon and adhere to collecting surfaces provided by the filter media which are oiled to cause the dust to adhere thereto. The dust is retained in the air filter panel as an accumulating dust load until the air filter panels are removed, cleaned, re-oiled and again inserted for use. Two factors of primary importance in such filters are the efficiency of the filter in removing dust from the air and the pressure drop through the filter, that is the resistance which the filter provides to the passage of air. It is, of course, desirable that the efficiency, which determines the ability of the filter to clean the air, be high. It is also desirable that the pressure drop be low, so that the filter does not unduly restrict the flow of air through the system [R. 116]. In earlier filters of this type (for example Respondents' type B which was manufactured prior to the infringing type P-5) these factors, particularly the pressure drop, change as more and more dust is accumulated in the filter, the pressure drop increasing as the dust load grows [R. 284]. Such increase in pressure drop is undesirable in that it unbalances the system which is normally constructed to deliver a certain amount of air [R. 285]. Further, the increased resistance of the filter can result in an insufficient amount of air being supplied in the particular system after the filter has been in use for a period of time [R. 284-286].

The patented filter utilizes for filter media corrugated sheets of wire screens which are set parallel to the gen-

eral direction of air flow through the filter. The corrugations (or crimps) in these sheets form valleys which provide air passages extending through the filter independently of the openings of the screen mesh. The corrugated wire screen sheets are stacked one above the other to divide the filter panel both in the horizontal and vertical dimensions into a multiplicity of small passages. Moreover, the corrugations are formed in a herringbone pattern, that is, with a sharp bend to provide an abrupt change in the direction of the corrugation and, accordingly, in the air passages through the filter formed by the valley of the corrugation [R. 110-112, 1372-1374].

The trial court found, as will be further considered herein, that this arrangement constituted a new combination of elements which for the first time provided a filter having a high efficiency and a low pressure drop which did not rise appreciably as dust collected upon the filter.

After twelve days of trial, in an oral opinion [R. 819] the trial court held each of the claims sued upon valid and infringed, and judgment was entered for Petitioner on February 26, 1952 [R. 67]. Appellants appealed from this judgment but, prior to the date set for hearing such appeal, filed a Motion to Reopen and Remand based upon purportedly newly discovered evidence. The Court of Appeals remanded the case [R. 1472] to the trial court to receive evidence relating to an earlier filter, upon which Respondents' Motion to Remand had been based. After two additional days of trial the trial court entered a new judgment [R. 1177] which provided that the new evidence presented required no modification of the original judgment except that Petitioner was entitled to additional costs. Thereafter, Respondents appealed from the new

judgment and reappealed from the original judgment [R. 1183].

This extensive trial was required by the subject involved, the factual issues presented involving matters such as paths of air flow and the collecting action of the various filter media upon the impingement of tiny particles of dust, matters which cannot be determined by mere visual observation. Consequently, the bulk of the testimony was by expert witnesses, the operation and performance of the various filters involved and the effect of structural differences between them being determined and demonstrated by the results of carefully controlled comparative tests. To this end, each of the parties introduced in evidence the results of a large number of such tests. [For example, Exs. HH [R. 1075], VV [R. 1084], 11 [R. 956], 13 [R. 956A], 29 [R. 977], 30 [R. 984], 31 [R. 985], 54B1 [R. 1455 and 54B2 R. 1456].

After fully considering the extensive technical testimony, including the numerous comparative test results introduced, the trial court held Petitioner's patent valid and infringed. In support of its decision, the court entered 34 detailed Findings of Fact [R. 59-65, 1178-1181]. Those Findings which bear directly on the issue of invention may be summarized as follows:

(a) The claims in suit are directed to a *new combination of elements* which cooperate together to provide not only advantages in the cleaning of the air but benefits in the cost of manufacture, maintenance and upkeep [Find. 9, 29, R. 61, 1179].

(b) The filter of the patent in suit has a *new mode of operation* whereby at the outset portions of the air flow through the mesh of the screen members into adjoining

passages, but as the filter panels become loaded with dust the flow of air becomes more and more confined to flow through the passages, the dust accumulating progressively along the walls of the passages formed by the corrugations, permitting turbulent flow of air through the passages and through the mesh of the screen despite increasing dust load [Find. 4, 30, R. 59, 1179].

(c) The filter of the patent in suit *achieves new and surprising results* by combining high efficiency in removing dust from the air with a low pressure drop which does not increase rapidly and by providing a filter of low manufacturing and maintenance cost as well as ease of cleaning [Find. 6, 31, R. 60, 1180].

(d) The prior art relied upon by Respondents did not contain either the elements, mode of operation, or the new and surprising results of the filter of the Farr patent in suit nor would such filter have been obvious to one skilled in the art [Find. 32, R. 1180].

(e) The patent in suit has had a wide commercial success and was responsible for the development of Petitioner's rapidly expanding business [Find. 7, R. 60].

(f) Prior to the invention of the patent in suit, the art had expended great effort and money in the scientific study and testing of different air filter panels without the air filter panel of Petitioner's patent being suggested thereby [Find. 14, R. 63].

Despite these findings, the Court of Appeals reversed the trial court, holding the patent invalid as anticipated by a prior French patent to Niestle, No. 739,956 [R. 1062], under the authority this Court's decision in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U. S. 147. In its very brief opinion, the court takes no issue with any of

the above noted Findings which relate to the issue of invention. Indeed the only one mentioned is Finding of Fact 4 of which the court appears to approve. Instead, the court singles out Finding of Fact 13 [R. 62] and states simply that it does not "agree" with it. This Finding which is directed to the French Niestle patent, enumerates two structural differences between the structure of this patent and that of the patent in suit. The court not only fails to state the basis for its failure to "agree" with the finding, but recognizes such structural differences in its opinion. The first of these relates to the orientation of the filter members and, according to uncontradicted testimony renders the filter of the French patent impractical to manufacture [R. 772] as to which the trial court had found that among the advantages of the filter of the Farr patent were benefits in cost of manufacture [Find. of Fact 9, R. 61]. The Court of Appeals, without references to any testimony whatever or to this Finding states simply that the difference is "irrelevant", since "the same mechanism to collect the dust" results. The second structural difference recognized by the Court of Appeals relates to the use of filter media having impervious walls in the French patent whereas the patent in suit requires that such walls be of open mesh to permit the passage of air. As to this difference the court, without reference to any evidence whatever, merely states that it presents none of the "unusual or surprising consequences" of the *A. & P. Tea Co.* case. In this the court simply ignores the explicit findings of the trial court to the contrary [Find. of Fact 6, 31; R. 60, 1180].

Reasons for Granting the Writ.

1. The decision of the Court below construes this Court's decision in the *A. & P. Tea Co.* case so as to effect a fundamental change in the law, a change which was clearly not intended by this Court.

Petitioner is not here seeking merely a review of the factual issues concerning the validity of its patent. To the contrary, Petitioner is seeking to have resolved a fundamental question as to the proper application of this Court's recent decision in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U. S. 147.

In the *A. & P. Tea Co.* case the trial court had found only that one element of a combination was "novel" and that the combination was "new and useful." This Court held that such findings did not satisfy the standard of invention which, as a matter of law, must be satisfied if a patent to a combination of old elements is to be sustained. The Court thereafter set forth the proper standard of invention in such cases.

There is no parallel in the instant case. Here the trial court made detailed and explicit findings of fact which fully meet the legal standard of invention enunciated by this Court in the *A. & P. Tea Co.* case. Thus, the trial court found that the patent in suit describes and claims combination of elements [described in Find. of Fact 3] which is a *new* combination [Find. of Fact 9 and 29; R. 61 and 1179]. The mode of operation of this combination [described in Find. of Fact 4 and 30; R. 59, 1179], is *new* [Find. of Fact 10, 11, 12, 13, 30 and 32; R. 61-63, 1179 and 1180]. The results achieved [described in Find. of Fact 6 and 31; R. 60 and 1180] are *new* and *surprising* [Find. of Fact 31 and 32; R. 1180].

The filter was not obvious to one skilled in the art [Find. of Fact 32; R. 1180].

Without regard to these various findings nor to any testimony in the record, the Court of Appeals simply selected one prior art patent (Niestle No. 739,956), noted two structural differences between such patent and the patent in suit, and concluded that one of these differences was "irrelevant" and that the other did not create patentable novelty under the *A. & P. Tea Co.* case.

The import of this decision is simply that the Court of Appeals has interpreted the *A. & P. Tea Co.* case as rendering inapplicable Rule 52(a) of the Federal Rules of Civil Procedure to the question of invention in patent cases. The findings of the trial court fully satisfy every factual requirement prescribed by this Court as necessary to meet the legal standard of invention. The appellate Court did not set such findings aside as clearly erroneous, to the contrary, it simply ignored them, relying solely upon the *A. & P. Tea Co.* case as authority for this approach.

Such a construction of the *A. & P. Tea Co.* case establishes a fundamental change as to the scope of appellate review in patent cases. Not only is such change contrary to the prior law as unequivocally established by this Court in *Graver Tank & Mfg. Co. v. Linde Air Prod. Co.* (1948), 336 V. S. 271, 274, but is wholly unsupported by the *A. & P. Tea Co.* case.

2. The question of the effect to be accorded to findings of fact on the issue of invention in patent cases is of paramount importance to the patent bar and to the Federal Courts which appear to be in hopeless conflict and confusion. Thus, among the most recent decisions of

the Courts of Appeal, some[1] have taken the position that the question of invention in its entirety is one of law and that findings are at most merely persuasive on the question. Other Courts,[2] while recognizing that the standard of invention to be applied is a matter of law, attach to the supporting findings of fact the full import of Rule 52(a) of the Federal Rules of Civil Procedure.

The confusion appears to have arisen from the differences in the majority and concurring opinions of this Court in *A. & P. Tea Co. v. Supermarket,* 340 U. S. 197. In the majority opinion Mr. Justice Jackson carefully points out that no findings are being set aside, that the findings below were inadequate to sustain the invention and that the basis of the decision was the failure of the lower Courts to apply the proper standard of invention. The concurring opinion of Mr. Justice Douglas, however, makes no reference to the findings of fact below but to the contrary states simply, "the question of validity of a patent is a question of law" 340 U. S. at 155. No later decision by this Court deals with the matter since despite numerous petitions for certiorari which have been filed, this Court has not reviewed a case involving the validity of a patent since its decision in the *A. & P. Tea Co.* case in 1950.

It is Petitioner's contention that those courts are in error which have construed the *A. & P Tea Co.* case as emasculating Rule 52(a) on the question of validity in

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[1]*Blish, Mize and Silliman Hardware Company v. Time Saver Tools* (C. A. 10 1956), 236 F. 2d 913; *Glitsch & Sons v. Wyatt Metal* (C. A. 5, 1955), 224 F. 2d 331.

[2]*Helms Products v. Lake Shore Mfg. Co.* (C. A. 7 1955), 227 F. 2d 677; *Steffan & Weber Heating and Sheet Metal Company* (C. A. 8 1956), 237 F. 2d 601.

patent cases. Such construction is wholly unsupported by the majority opinion, moreover, as recognized by this court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271, 274, in patent cases more than any other Rule 52(a) must be vigorously applied if the proper result is to be reached by the courts. Thus, the difficulty of presenting the highly technical factual issues to the trial court in patent cases is well recognized and, as in the instant case, frequently necessitates protracted and expensive trials involving extensive expert testimony coupled with actual demonstrations of the operation and characteristics of the devices involved. The nature of the appellate proceeding precludes more than the most cursory explanation of the frequently complex technical aspects of the several defenses with which a patentee is normally confronted. Consequently, the findings of the trial court should weigh most heavily and Rule 52(a) of the Federal Rules of Civil Procedure should be most scrupulously followed.

Conclusion.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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Attorneys for Petitioner.

APPENDIX A.

"§101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

"§103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Federal Rules of Civil Procedure

"Rule 52. Findings by the Court.

(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes

of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b)."

APPENDIX B.

Opinion of the United States Court of Appeals for the Ninth Circuit.

No. 13,352. Oct. 19, 1956.

Jules D. Gratiot and Air-Maze Corporation, Appellants, vs. Farr Company, a corporation, Appellee.

Appeal from the United States District Court for the Southern District of California, Central Division.

Before: DENMAN, Chief Judge, and McALLISTER and BARNES, Circuit Judges.

DENMAN, Chief Judge:

Appellants, hereafter Gratiot, appeal from a judgment holding valid a patent owned by the Farr Company, hereafter Farr, and that it was infringed by a device of Gratiot and awarding damages to Farr and enjoining Gratiot from further use of his device. Gratiot contends that the court erred in holding that Farr's patent had not been anticipated and hence that it is valid.

The patent awarded is for a filter to free the air from dust. Farr admits that every element in his device has had a precedent use but claims novelty in their combination. In this situation, our approach to the problem of patentable novelty is stated by the Supreme Court to be:

> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans." A. & P. Tea Co. v. Supermarket Corp., 340 U. S. 147, 152.

The court's findings, 3 and 4, prepared for the court by Farr, describe the devices as follows:

> "3. The Farr patent in suit discloses an air filter panel operating on the principle of impingement of particles on collecting surfaces, which collecting surfaces are wire screen members positioned so that the air is introduced along the planes of the members, and the wire screen members are corrugated to divide the panel in two dimensions into passages through the panel, which passages change abruptly in direction.
>
> "4. At the start of the operation of the air panels of the patent in suit portions of the air flow through the mesh of the screen members into the adjoining passages but as the panels become loaded with dust the flow of air becomes more and more confined to flow through the passages."

Gratiot contended that, *inter alia,* Farr's device was anticipated by the patent granted by France to one Niestle. On this the court found:

> "The device of the French Patent No. 739,956 to Niestle, Defendants' Exhibit B, Tab 15, is a filter made of expanded sheets set at right angles to the intended flow of air rather than parallel as in the Farr patent in suit. When made of metal gauze and oiled the expanded sheets would present a solid wall. The French patent to Niestle does not operate by the same mode of operation referred to in Finding 4 or achieve the advantages of the Farr patent in suit."

We do not agree with this finding. The French patent when constructed has the air pass through the same channels as the Farr device. Its claims are:

> "1. Filter to arrest dust in a gaseous current, characterized by elements cut to form slots and

pressed in such a way as to separate the lips of these slots, while the elements are arranged with respect to each other so as to constitute a series of conduits between the lips of the slots, in which the gas to be purified circulates; the dust in the gas is arrested by aqueous or viscous products, such as oil, adhering to the said elements, *e. g.*, by previous immersion.

"2. The elements are superposed in such a way as to constitute zigzag conduits, in which the gas to be purified circulates.

"3. Embodiment of claim 2, characterized thereby, that the lips of the slots of two or more adjacent elements are interconnected and thus assure the formation of conduits of considerable length, forcing the gas to follow a course between sharply staggered points; these marked changes of direction favor the deposition of the dust.

"4. The elements are cut out in metal gauze.

"5. The metal gauze has meshes fine enough for the liquid to fill them by capillary action and form a continuous, thick liquid film, favoring the deposition of the dust suspended in the gas.

"6. Another embodiment, characterized thereby, that the elements are cut out in metal plates perforated with holes of small diameter.

"7. Grooves are made on the solid part of the metal plate constituting the element, causing the oil to be retained on these plates and favoring the deposition of the dust."

The mere fact that the "elements," *i. e.*, the metal gauze screens having larger slot openings than those of the gauze, are placed at right angles to the flow of air is irrelevant, since the angled slot passages surrounded by the

screened gauze give exactly the mechanism to collect the dust as the Farr device. This is also shown in figure 5 of the Niestle patent and exhibit KY introduced in evidence.

The fact that in using these identical air passages of the mechanism, the French patent contemplates using oil so heavy that it closes the gauze apertures does not create patentable novelty in having a gauze of larger apertures and using an oil so thin that air may pass through the gauze holes until the deposited dust closes them. Here are none of the "unusual or surprising consequences" of the A. &. P. Tea Co. case, *supra,* at page 152:

> "This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned, and there is nothing to indicate that the lower courts scrutinized the claims in the light of this rather severe test."

The judgment is reversed and judgment ordered entered for the appellant.

(Endorsed): Opinion. Filed, Oct. 19, 1956.

Paul P. O'Brien, Clerk.

No. 13,352.

United States Court of Appeals for the Ninth Circtuit.

Jules D. Gratiot and Air-Maze Corporation, Appellants, vs. Farr Company, a corporation, Appellee.

JUDGMENT.

Appeal from the United States District Court for the Southern District of California, Central Division.

This cause came on to be heard on the Transcript of the Record from the United States District Court for the Southern District of California, Central Division, and was duly submitted.

On consideration whereof, it is now here ordered and adjudged by this Court, that the judgment of the said District Court in this cause be, and hereby is reversed, with costs in favor of the Appellants, and against the Appellee, and that judgment be, and hereby is ordered entered for the Appellants.

IT IS FURTHER ORDERED and adjudged by this Court that the Appellants recover against the Appellee for their costs herein expended and have execution therefor.

(Endorsed): Judgment. Filed and Entered: October 19, 1956.

Paul P. O'Brien, Clerk.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. .....

FARR COMPANY, a corporation,

Petitioner,

vs.

JULES D. GRATIOT and AIR-MAZE CORPORATION,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

To the Supreme Court of the United States:

A.
Opinions Below.

The opinion of the District Court was oral and unreported, but appears at R. 819. The opinion of the Court of Appeals is reported at .....F. 2d....., 111 U. S. P. Q. 170.

B.
Statement of Jurisdiction.

Petitioner invokes the jurisdiction of this Court under Title 28, U. S. C., Section 1254(1).

C.

Counterstatement of the Case.

This is a run-of-mill action for patent infringement. The District Court entered judgments [R. 67, 1182] sustaining the validity and infringement of the patent in suit. The Court of Appeals for the Ninth Circuit reversed such judgment, holding the patent in suit invalid for lack of invention, under the authority of this Court's decision in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U. S. 147.

The Petition in effect seeks from this Court a review of the factual issues concerning the validity of the Farr patent in suit, stating: "Petitioner is not seeking *merely* a review of the factual issues (p. 8.)" The Petition proceeds to argue the factual issues with reference to the evidence and not merely the findings of fact of the District Court (pp. 2-4, 7). Although we do not agree with the evidentiary facts as stated by the Petition, we do not believe that a discussion of the facts as shown by the evidence will be helpful to the Court at this time and we do not discuss them herein.

The only reason actually set forth in the Petition for its allowance is the assertion by Petitioner that the Court of Appeals abused its discretion by not accepting the Findings of Fact of the District Court on the issue of validity of the Farr patent in suit. The Petition, in effect, asks this Court to substitute its judgment for the Court of Appeals as to the validity issue, or, in the

alternative, to hold that a finding of validity by a district court is binding on all of the appellate courts.

Petitioner's purported summary of the relevant findings of fact of the District Court (pp. 5-6) are misleading and erroneous in the following particulars:

(a) Petitioner neglects to point out that the District Court found that the Farr patent in suit discloses a new combination of *old* elements [Finding 9, R. 61], stating in its opinion:

> "As the plaintiff has stated here, all of the elements which are disclosed in plaintiff's claims in the patent in suit are old. Each one of them has existed before or been used in some one or another previous device or, as I say, disclosed in a previous patent [Opinion, R. 820]."

(b) Petitioner's representation (p. 6) that the District Court found that: "The prior art relied upon by Respondents did not contain . . . the elements . . . of the filter of the Farr patent in suit . . ." is plainly erroneous in view of the District Court's Finding 9 and Opinion, as pointed out under (a), above, that all of the elements of the claims were old in the prior art.

The District Court's oral opinion was rendered immediately at the conclusion of the trial and arguments by counsel, and not after any further consideration as implied by the Petition (p. 5). Furthermore, all of the findings of fact were prepared by Petitioner's counsel and entered by the District Court without change.

Most significantly, the District Court made *no* finding of fact to the effect that "the old elements which made up this device perform any additional or different function in the combination than they perform out of it," as appears to be enjoined by this Court in the *A. & P.* case, *supra,* at page 152. This omission was called to the attention of the Petitioner by our briefs in the Court of Appeals, and before remand to the District Court for further trial, and presumably thereby to the attention of the District Court, yet the District Court in its second set of findings of fact [R. 1178-1181] made no finding with respect thereto and Petitioner asked for none. Only claims 4, 5, 7, and 8 of Farr patent No. 2,286,479 in suit were involved in this action [Finding 1, R. 59], and these were the only claims held invalid. Claims 1, 2, 3, and 6 were not in issue. Consequently, regardless of the outcome of this case Petitioner still has its patent with the unadjudicated claims therein, for what it is worth.

D.
Questions Presented.

The Petition (pp. 8-10) presents two "questions" upon which it asks this Court for a decision:

(1) Did the Court of Appeals below properly apply the rule of this Court's decision in the *A. & P. Tea Co.* case, *supra,* to the facts in this case?

(2) How far are findings of fact as to the validity of a patent binding on the appellate courts?

E.
Argument.

(a) In General.

This action for patent infringement prays for a preliminary and permanent injunction [R. 5], and such permanent injunction has been ordered by the District Court [R. 67]. This is an action in equity, and "In equity, matters of fact as well as law are reviewable." (See: *Virginian R. Co. v. United States,* 272 U. S. 658, 675, 47 S. Ct. 222, 71 L. Ed. 463; *District of Columbia v. Pace,* 320 U. S. 698, 64 S. Ct. 406, 88 L. Ed. 408.)

Here the Court of Appeals had the record before it as to both the facts and the law, and under the foregoing authorities had full power to review the facts and reverse the District Court on the issue of validity of the Farr patent in suit.

The Court of Appeals for the Ninth Circuit at all times has clearly had in mind the requirements of Rule 52(a) of the Rules of Civil Procedure as to patent infringement suits. (See: *Maurice A. Garbell, Inc. v. Consolidated Vultee Aircraft Corp.,* 204 F. 2d 946, cert. denied 346 U. S. 873; *Hansen v. Safeway Stores,* 238 F. 2d 336; *Hall v. Wright,* .....F. 2d ....., 112 U. S. P. Q. 210.)

(b) The Court Below Properly Applied the Law.

The Court of Appeals properly relied upon and correctly applied the rule of the *A. & P. Tea Co.* case, *supra.*

Here, as in the *A. & P. Tea Co.* case, all the elements of the claims of the patent in suit were old in the prior

art. Here, as in the *A. & P. Tea Co.* case, the District Court made no finding of fact that any of such elements of the claims in suit "perform any additional or different function in the combination than they perform out of it." Hence, the findings of the District Court in this case did not satisfy the factual requirements prescribed by this Court in the *A. & P. Tea Co.* case, the Petition (p. 9) to the contrary notwithstanding.

In the *A. & P. Tea Co.* case, the District Court made elaborate findings of fact on the normal indicia of invention, finding in effect: (a) that there was a longfelt need in the art (Findings 8, 9, 13); (b) the satisfaction of that need by the Turnham invention in suit (Findings 10, 11, 13); (c) the Turnham invention provided a substantial increase in efficiency (Finding 14); (d) the Turnham invention defined a new combination of old elements brought together for the first time (Finding 15); (e) that there was no similiarity between the patent in suit and the prior art (Finding 17); and (f), finally, that the patentee of the patent in suit "met the test of invention" (Finding 19).

In the face of such findings of fact in the *A. & P. Tea Co.* case, this Court reversed both courts below and held the Turnham patent invalid for lack of invention without discussing the findings of fact.

In this case, the Court of Appeals, on generally similar findings of fact, held the Farr patent in suit invalid for lack of invention, quoting this Court and holding that

the District Court had not applied the proper test of invention. A comparison of the actual findings of fact in both this and the *A. & P. Tea Co.* case indicates that here the Court of Appeals was fully justified in coming to its conclusion that the judgment of the District Court was clearly wrong.

The Court of Appeals here considered the Niestle (French) prior art patent, came to the conclusion that the Farr patent in suit is invalid for lack of invention over the Niestle patent under the test prescribed by this Court in the *A. & P. Tea Co.* case, held, in effect, that the District Court's findings to the contrary were clearly erroneous, and reversed the judgment.

Whenever this Court or a Court of Appeals reverses a decision to hold a patent either valid or invalid, without specifically and by number setting aside findings of fact by a District Court, it inferentially sets aside any and all findings to the contrary. Either we misunderstand the Petitioner's argument or it is merely caviling because the opinion of the Court of Appeals here is brief and does not go into great detail in discussing the findings of the District Court. We do not think there is any such obligation on a Court of Appeals, and apparently this Court feels the same, because in the *A. & P. Tea Co.* case this Court did not in any way discuss the elaborate findings of fact of the District Court there in support of the holdings of validity.

In any event, the Court of Appeals below clearly had in mind the test of invention prescribed by this Court in

the *A. & P. Tea Co.* case, and, we suggest, correctly applied such test to hold the Farr patent in suit invalid. The decision by the Court of Appeals does not in any way change the scope of appellate review in patent cases, as suggested by Petitioner.

(c) There is No Confusion Among the Courts as to the Effect of Findings of Fact.

Petitioner argues (p. 9) that the Federal courts are "in hopeless conflict and confusion" as to the effect to be accorded findings of fact on the issues of invention. We find no such confusion among the courts. True, this Court and the Courts of Appeal sometimes refer to the findings of fact and sometimes do not in reaching a conclusion as to the validity of a patent which is contrary to that of the trial court, but, we suggest, this does not indicate any confusion. There is no evidence of any "emasculation" of Rule 52(a) of the Rules of Civil Procedure as suggested by the Petition (p. 10).

It has been fundamental law, since the decision of this Court in 1850 in the leading case of *Hotchkiss v. Greenwood,* 11 How. 248, 265, 13 L. Ed. 683, 690, that a patent which does not display "more ingenuity or skill . . . than that possessed by an ordinary mechanic" is invalid for want of patentable invention.

The decision of the Court of Appeals in this case merely applied this rule, indicating in effect in its opinion that the District Court did not apply the proper test of invention as to the Farr patent in suit.

Petitioner seeks to raise the question as to what court can apply this fundamental doctrine of the patent law and under what circumstances.

This Court has never hesitated to apply this fundamental doctrine where it has found patents invalid, in spite of and without discussing the contrary findings of fact of the District Court. (See: *A. & P. Tea Company* case, *supra; Mandel Bros., Inc. v. Wallace,* 335 U. S. 291; *Funk Bros. Seed Co. v. Kalo Inoculant Co.,* 333 U. S. 127.)

Similarly, the Courts of Appeals have had no hesitancy in applying the fundamental principle to hold patents invalid, in spite of a contrary holding by the District Court. (See: *United Specialties Co. v. Industrial Wire Cloth Products Corp.,* 186 F. 2d 426 (C. A. 6th, 1951); *Montgomery Ward & Co. v. Buer,* 186 F. 2d 614 (C. A. 6th, 1951); *Paramount Industries, Inc. v. Solar Products Corp.,* 186 F. 2d 999 (C. A. 2d., 1951); *Youngs Rubber Corp. v. Allied Latex Corp.,* 188 F. 2d 945 (C. A. 2d, 1951); *Boston Metals Co. v. Air Products, Inc.,* 193 F. 2d 535 (C. A. 4th, 1951); *Associated Folding Box Co., Inc. v. Levkoff,* 194 F. 2d 252 (C. A. 1st, 1952); *Whitman v. Andrus,* 194 F. 2d 270 (C. A. 6th, 1952); *General Motors Corp. v. Estate Stove Co.,* 201 F. 2d 645 (C. A. 6th, 1953); *Texas Miller Hat Corp. v. Switzer Bros., Inc.,* 201 F. 2d 824 (C. A. 5th, 1953); *Allied Wheel Products, Inc. v. Rude,* 206 F. 2d 752 (C. A. 6th, 1953); *Kwikset Locks, Inc. v. Hillgren,* 210 F. 2d 483 (C. A. 9th, 1954); *Buffalo-Springfield Roller Co. v. Galion Iron*

Works Mach. Co., 215 F. 2d 686 (C. A. 6th, 1954); *United States Air Conditioning Corp. v. Governair Corp.*, 216 F. 2d 430 (C. A. 10th, 1954); *Gordon Cartons, Inc. v. Alford Cartons*, 218 F. 2d 246 (C. A. 4th, 1954); *Pollard v. American Phenolic Corp.*, 219 F. 2d 360 (C. A. 4th, 1955); *Powder Power Tool Corp. v. Powder Actuated Tool Co.*, 230 F. 2d 409 (C. A. 7th, 1956); *Blish, Mize & Siliman Hardware Co. v. Time Saver Tools, Inc.*, 236 F. 2d 913 (C. A. 10th, 1956).)

Consequently, we suggest that there is no conflict or confusion among the courts in applying the fundamental principle of law, and that this is the important point so far as the public interest is concerned.

Petitioner merely seeks to persuade this Court to make a general statement as to the effect to be given on appeal to findings of fact of a District Court. This Court has clearly done so in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271. And see: *McAllister v. United States*, 348 U. S. 19, 20, 75 S. Ct. 6, 99 L. Ed. 20. No further declaration of this Court's views on the question is required.

The issues presented by this action are of interest only to the parties herein. Particularly apposite is the comment of Mr. Chief Justice Taft in *McAllister v. United States, supra*, as follows:

> ". . . it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that

of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head."

Layne & Bowler Corp. v. Western Well Works, Inc., 261 U. S. 387, 67 L. Ed. 712, 43 S. Ct. 422.

F. Conclusion.

It is submitted that this case does not display any sufficient reason for the grant of a writ of certiorari within the rulings and practice of this Court. The purported questions attempted to be raised by the Petition are not in fact questions raised by the record, and even if deemed raised, have long been answered by controlling rulings of this Court. Thus, no important question of Federal law remains to be decided by this Court.

The public interest has been served by the holding of the Court of Appeals that the Farr patent in suit is invalid.

It is suggested that the Petition should be denied.

Respectfully submitted,

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